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EXAMINER
FRENEL, VANEL

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/862,577
Filing Date: May 21, 2001
Appellant(s): HARTIGAN, WILLIAM R.

MAILED

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GROUP 3600

Mark D. Trenner
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 22 th, 2007 appealing from the

Office action mailed May 26th, 2006.

(1) Real Party in interest

A Statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20040083125	ALMEIDA et al.	4-2004
2002/0035488	AQUILA et al.	3-2002
5752236	SEXTON et al.	5-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-9 and 11-22 are rejected under 35 U.S.C. 103 (a). This rejection is set forth prior Office Action. The rejection is set forth below as it appears in the previous Office Action.

Claims 1-4, 6-9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Almeida et al (2004/0083125), Aquila et al (2002/0035488) in view of Sexton et al (5,752,236).

(A)   As per claim 1, Almeida discloses a computer-implemented method for providing insurance information across a network, comprising: ·

receiving an access code from a user via the network (See Almeida, Page 4, Paragraph 0049);

receiving a password from a user via the network (See PIN in Almeida as a form of password Page 4, Paragraph 0050);

executing computer-implemented instructions for determining a user class of a user from the access code and password, the user class being one of an agent or a certificate holder (See Almeida, Page 4, Paragraphs 0048-0049);

in the event that the user is an agent, permitting the agent to enter insurance information including a certificate of insurance for an insured (See Almeida, Page 4, Paragraphs 0049-0051);

storing the insurance information along with the date and time of entry as a record in a database (See Aquila, Page 12, Paragraphs 0226-0229);

executing computer-implemented instructions for generating an access code and password corresponding to the insured (See Almeida, Page 4, Paragraphs 0049-0050);

in the event that the user is a certificate holder, permitting the certificate holder to view insurance information for the insured corresponding to the insured's access code and password (See Almeida, Page 5, Paragraphs 0055-0057);

receiving a set of insurance requirements from the certificate holder via the network (See Almeida, Page 4, Paragraphs 0049-0050).

Almeida and Aquila do not explicitly disclose that the method having executing computer-implemented instructions for comparing the set of insurance requirements from the certificate holder to the insurance information for the insured to determine if the insurance information complies with the set of insurance requirements; and executing computer-implemented instructions for displaying an exception report to the certificate

holder if the insurance information fails to comply with any of the set of insurance requirements, the exception report indicating which of the insured's insurance information violated the set of insurance requirements.

However, these features are known in the art, as evidenced by Sexton. In particular, Sexton suggests that the method having executing computer-implemented instructions for comparing the set of insurance requirements from the certificate holder to the insurance information for the insured to determine if the insurance information complies with the set of insurance requirements (See Sexton, Col.4, lines 40-67; Col.11, lines 50-67); and executing computer-implemented instructions for displaying an exception report to the certificate holder if the insurance information fails to comply with any of the set of insurance requirements, the exception report indicating which of the insured's insurance information violated the set of insurance requirements (See Sexton, Col.4, lines 40-67; Col.11, lines 50-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Sexton within the combined teachings of Almeida and Aquila with the motivation of providing inputting into the apparatus regulatory requirements to be met by a life insurance contract; comparing in the apparatus each of the contracts with the regulatory requirements; and displaying the resulting premium obligation, death benefit and cash value amounts allocated to each of the contracts (See Sexton, Col.48-53).

(B)   As per claim 2, Almeida discloses the method wherein a cerificate holder may

enter a plurality of access codes and passwords, each of the plurality of access codes

and passwords corresponding to a single insured of a plurality of insureds (See

Almeida, Page 4, Paragraph 0050).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as

given above in the rejection of claim 1 above, and incorporated herein.

(C)   As per claim 3, Almeida discloses the method further comprising:

permitting the certificate holder to view insurance information for each of the plurality of

insureds simultaneously via the network (See Almeida, Page 4, Paragraph 0050); and

displaying a compliance report to the certificate holder, the compliance report indicating

which of each of the plurality of insureds' insurance information violates the set of

insurance requirements (See Almeida, Page 4, Paragraph 0050).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as

given above in the rejection of claim 1 above, and incorporated herein.

(D)   As per claim 4, Aquila discloses the method wherein the compliance report is

presented as a table, the table having one row corresponding to each of the plurality of

.insureds and one column corresponding to each requirement of the set of insurance

requirements (See Aquila, Page 10, Paragraphs 0171-0190).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as

given above in the rejection of claim 1 above, and incorporated herein.

(E)   As per claim 6, Almeida discloses a computer-implemented method for retrieving

and evaluating insurance information across a network, comprising:

inputting an access code and password for at least one insured (See Almeida,

Page 4, Paragraphs 0048-0050);

receiving at least one insurance record comprised of at least one category of

insurance coverage for the at least one insured (See Almeida, Page 4, Paragraphs

0048-0051);

inputting at least one user-specified insurance requirement of a certificate holder

who is not the insurance agent (See Almeida, Page 4, Paragraph 0049).

Almeida and Aquila do not explicitly disclose executing computer-implemented

instructions for comparing the insurance record for the insured to the user-specified

insurance requirement of the certificate holder to determine if the insurance information

complies with the user-specified requirement; and displaying the results of the

comparison.

However, these features are known in the art, as evidenced by Sexton. In particular,

Sexton suggests executing computer-implemented instructions for comparing the

insurance record for the insured to the user-specified insurance requirement of the

certificate holder to determine if the insurance information complies with the user-

specified requirement; and displaying the results of the comparison (See Sexton, Col.4,

lines 40-67; Col.11, lines 50-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Sexton within the combined teachings of Almeida and Aquila with the motivation of providing inputting into the apparatus regulatory requirements to be met by a life insurance contract; comparing in the apparatus each of the contracts with the regulatory requirements; and displaying the resulting premium obligation, death benefit and cash value amounts allocated to each of the contracts (See Sexton, Col.48-53).

(F)   As per claim 7, Aquila discloses the method wherein the step of comparing the insurance record to the user-specified insurance requirement comprises:

determining whether the user has specified a coverage minimum for at least one insurance category (See Aquila, Page 3, Paragraph 0070);

determining from the at least one category of insurance coverage comprising the at least one insurance record whether the at least one insured's coverage meets or exceeds the coverage minimum (See Aquila, Page 17, Paragraphs 0304-0305);

creating a table, the table comprised of at least one row corresponding to each of the at least one insured and at least one column corresponding to each of the at least one categories of insurance coverage, the intersection of the at least one row and at least one column forming at least one cell (See Aquila, Page 10, Paragraphs 0171-0190);

and

placing in the at least one cell an indicator corresponding to the results of

determining whether the at least one insured's coverage meets or exceeds the coverage minimum (See Aquila, Page 17, Paragraphs 0304-0305).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as given above in the rejection of claim 1 above, and incorporated herein.

(G)   As per claim 8, Aquila discloses the method wherein the indicator further indicates whether the at least one insured' s coverage is cancelled or expired (See Aquila, Page 8, Paragraph 0140).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as given above in the rejection of claim 1 above, and incorporated herein.

(H)   As per claim 9, Aquila discloses the method wherein the indicator indicating that the at least one insured's coverage is expired is the date of expiration (See Aquila, Page 8, Paragraph 0140).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as given above in the rejection of claim 1 above, and incorporated herein.

(I)   As per claim 11, Aquila discloses the method further comprising executing a division function for limiting the contents of the exception report (See Aquila, Page 21, Paragraphs 0362-0363).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as given above in the rejection of claim 1 above, and incorporated herein.

(J)   As per claim 12, Almeida discloses the method wherein the division function

includes at least one of the following categories: subsidiary, division, region,

branch office, project territory loçation, or product (See Almeida, Page 2, Paragraph

0020).

(K)   As per claim 13, Almeida discloses the method wherein the set of insurance

requirements received from the certificate holder are minimum insurance requirements

the certificate holder requires of the insured (See Almeida, Page 4, Paragraph 0050).

(L)   As per claim 14, Almeida discloses the method further comprising providing the

holder with a compliance report for at least one of a plurality of requirement sets (See

Almeida, Page 4, Paragraph 005).

(M)   As per claim 15, Almeida discloses a system of providing proof of an insured's

insurance via a network comprising:

        at least one computer-readable medium (See Almeida, Page 3, Paragraph

0031);

        computer-implemented instructions provided on the at least one computer-

readable medium, the computer-implemented instructions for:

        receiving insurance information for proof of insurance from an

agent for an insured of the agent (See Almeida; Page 4, Paragraphs 0048-0051);

storing the insurance information electronically in a database (See Aquila, Page 12, Paragraphs 0226-0229).

Almeida and Aquila do not explicitly disclose that the system having comparing the insurance information to a certificate holder's insurance requirements for the insured to determine whether the insured complies with the certificate holder's insurance requirements; and providing the insurance information as proof of insurance from the database over a network to the certificate holder who is not the agent, the proof of insurance indicating whether the insured complies with the certificate holder's insurance requirements.

However, these features are known in the art, as evidenced by Sexton. In particular, Sexton suggests that the system having comparing the insurance information to a certificate holder's insurance requirements for the insured to determine whether the insured complies with the certificate holder's insurance requirements (See Sexton, Col.4, lines 40-67); and providing the insurance information as proof of insurance from the database over a network to the certificate holder who is not the agent, the proof of insurance indicating whether the insured complies with the certificate holder's insurance requirements (See Sexton, Col.4, lines 40-67 to Col.5, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Sexton within the combined teachings of Almeida and Aquila with the motivation of providing inputting into the apparatus regulatory requirements to be met by a life insurance contract; comparing in the apparatus each of the contracts with the regulatory requirements; and displaying the

resulting premium obligation, death benefit and cash value amounts allocated to each of

the contracts (See Sexton, Col.48-53).

(N)   As per claim 16, Aquila discloses the system further comprising computer-

implemented instructions for generating a compliance report summarizing the

compliance status of each coverage for all insured (See Aquila, Page 17, Paragraph

0304).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as

given above in the rejection of claim 1 above, and incorporated herein.

(O)   As per claim 17, Almeida discloses the system wherein providing the insurance

information to the certificate holder is for each insured for whom the certificate holder

has an access code and password (See Almeida, Page 4, Paragraph 0050).

(P)   As per claim 18, Almeida discloses the system further comprising computer-

implemented instructions for issuing electronic notices to the holder (See Almeida, Page

4, Paragraph 0050).

(Q)   As per claim 19, Aquila discloses the system further comprising computer-

implemented instructions for indicating whether the at least one insured's coverage is

cancelled or expired (See Aquila, Page 8, Paragraph 0140).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as given above in the rejection of claim 1 above, and incorporated herein.

(R)   As per claim 20, Almeida discloses the system further comprising computer-implemented instructions for providing a certificate holder with internet access to the insurance information from a centralized certificate storage repository (See Almeida, Page 4, Paragraph 0050).

(S)   As per claim 21, Almeida discloses the system further comprising computer-implemented instructions for comparing certificates to a certificate holders custom requirements (See Almeida Page 4, Paragraph 0050).

(T)   As per claim 22, Aquila discloses the system further comprising computer-implemented instructions for validating insurance ratings by at least one independent rating organization (See Aquila, Page 20, Paragraph 0352).

The motivation for combining the teachings of Almeida, Aquila and Sexton is as given above in the rejection of claim 1 above, and incorporated herein.

(10) Response to Argument

In the Appeal Brief filed on 9/22/07, Appellant makes the followings arguments:

(i) The Examiner has failed to make a prima facie case which would support a rejection of Appellant's claimed under 35 U.S.C. 103 (a).

(ii) The Examiner has consistently relied upon prior art whose purpose and

function is unrelated to the purpose and function of Appellant's claims. Appellant claims

relate to insurance certificates (which function to provide proof of insurance to

customers of the party covered by insurance policies), and the process of evaluating

such certified insurance policies for compliance with insurance requirements.

Examiner will address Appellant arguments and relate point in sequence as they

appear in the Brief.

With respect to Appellant first point of argument, the Examiner respectfully

submitted obviousness is determined on the basis of the evidence as a whole and the

relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24

USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ

685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788

(Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA

1976). Using this standard, the Examiner respectfully submits that he has at least

satisfied the burden of presenting a *prima facie* case of obviousness, since he has

presented evidence of corresponding claim elements in the prior art and has expressly

articulated the combinations and the motivations for combinations that fairly suggest

Applicant's claimed invention.

Rather, Applicant does not point to any specific distinction(s) between the

features disclosed in the references and the features that are presently claimed. In

particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a

patentable invention without specifically pointing out how the language of the claims

patentably distinguishes them from the reference does not comply with the

requirements of this section." Applicant has failed to specifically point out how the

language of the claims patentably distinguishes them from the applied references.

Also, arguments or conclusions of Attorney cannot take the place of evidence. In re

Cole, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); In re Schulze, 52 CCPA

1422, 346 F.2d 600, 145 USPQ 716 (1965); Mertizner v. Mindick, 549 F.2d 775, 193

USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered

or modified and that there must be some reason why one skilled in the art would be

motivated to make the proposed modifications. However, although the Examiner

agrees that the motivation or suggestion to make modifications must be articulated, it is

respectfully contended that there is no requirement that the motivation to make

modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by

their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the

numerous court decisions supporting the position given above. The issue of

obviousness is not determined by what the references expressly state but by what they

would reasonably suggest to one of ordinary skill in the art, as supported by decisions in

In re DeLisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ

871; and In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988)

(citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further,

it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

    (i)   obviousness does not require absolute predictability;

    (ii)   non-preferred embodiments of prior art must also be considered; and

    (iii) the question is not <u>express</u> teaching of references, but what they would

suggest. Therefore, Applicant's argument is not persuasive and the rejection is hereby

sustained.

With respect to Appellant's second argument. Examiner respectfully submitted

that He relied upon the clear teaching of Almeida for such a feature (See Page 4,

Paragraph 0050; Page 6, Paragraphs 0068-0072). Therefore, Applicant's argument is

not persuasive and the rejection is hereby sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

Thus, the teachings of Almeida, Aquila and Sexton when considered with the

knowledge that is generally available to one of ordinary skill in the art make obvious the

limitations that Appellant disputes.

For the above reasons, it is believed that the rejection should be sustained.

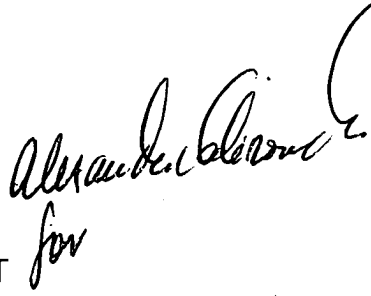Respectfully submitted,

Vanel Frenel

Patent Examiner

Art Unit 3627

December 18, 2007

CONFEREES

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